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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/746,556

12/22/2000

Dennis B. Gilbertson

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08/20/2003

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13  
EXAMINER

HENDRICKS, KEITH D

ART UNIT

PAPER NUMBER

1761

DATE MAILED: 08/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicant(s)

09/746,556

Applicant(s)

GILBERTSON ET AL.

Examiner

Keith Hendricks

Art Unit

1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21-52 is/are pending in the application.
- 4a) Of the above claim(s) 21-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

New claims 31-52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The use of the phrase "soy protein" is indefinite for the following reasons. The claims are incomplete for omitting essential elements, such omission amounting to a gap between the elements. The claims also fail to point out what is included or excluded by the claim language. Finally, where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term "soy protein" is stated by applicant (in the 5-19-03 response) to be used by the claims to "comprise soy grits and soy flour", while the accepted meaning is directed to an isolated protein fraction, i.e. simply "soy protein", as stated. Thus, the term as claimed is indefinite because the specification does not clearly redefine the term.

In the art, it is noted that soy flour and soy grits naturally contain soy protein (i.e. proteins from soy). Thus, "soy protein" cannot comprise the larger entities of soy flour and soy grits.

Applicants' specification does not expressly, specifically and explicitly state that by the term "soy protein", applicants mean "soy flour and soy grits." At page 5 of the instant response, applicants refer to page 3, lines 21-22 of the specification to support their position. However, further reference to other passages on page 3 of the specification, as well as the top of page 4, and original claims 1-2 and 16, demonstrate that this was not a clearly and specifically-defined term. The top of page 4 of the specification states that "while soy grits are described, it is believed that *other soy protein products* that do not require substantial hydration *are usable forms of soy protein*. The other soy products include soy germ, texturized soy protein and mixtures of these materials." (emphasis added). In fact, this passage does not even state "while the combination of soy grits *and soy flour* are described", as the main definition from which "other soy protein products" may vary.

Art Unit: 1761

Applicants' attempted definition of "soy protein" is not an art-accepted meaning. In fact, US Patent 6,589,584, which has a common inventor to that of the instant application, provides that the soy protein used therein is that of soy flour alone; see for example claim 1 of the reference.

Still further, reference is made to a previous rejection of claim 2, where it was unclear as to how a "food ingredient comprising soy grits and gluten" (claim 1), while "further comprising soy flour" in claim 2, may "comprise up to 100% of the soy protein fraction" by soy grits. Soy flour naturally contains soy proteins, and thus these two limitations appear to conflict with one another.

Finally, if applicants wish to claim "soy flour and soy grits", then there is no apparent reason why this is not clearly and specifically recited in the claims. It is noted, however, that if applicant truly intended the phrase "soy protein" to be solely limited to "soy flour and soy grits", then new claims 39 and 47, for example, would not be necessary. It is not understood why these two claims would be necessary, if applicants' specification had already clearly defined the phrase.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 31-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Feucht (DE 3708622). The references and rejection are taken as cited in a previous Office action.

Applicants' arguments filed May 19, 2003 have been fully considered but they are not persuasive. At page 5 of the response, applicants state that because the reference does not teach the use of both soy protein and soy grits, it does not anticipate the claims. This is not deemed persuasive for the reasons of record, and those stated in the rejection under 35 U.S.C. 112, second paragraph, above. Because the term "soy protein" is not properly defined within the claims, and instead remains open to interpretation based upon the non-specific teachings of the instant application and the knowledge in the art, the rejection is maintained.

Art Unit: 1761

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 31-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson (US PAT 4,109,018, of record), in view of the combination of GB 1 522 439, and Feucht. The references and rejection are taken as cited in a previous Office action.

Applicants' arguments filed May 19, 2003 have been fully considered but they are not persuasive. At pages 5-9 of the response, applicants state that the Feucht reference does not teach the use of both soy protein and soy grits. This is not deemed persuasive for the reasons of record, and those stated in the rejection under 35 U.S.C. 112, second paragraph, above. Because the term "soy protein" is not properly defined within the claims, and instead remains open to interpretation based upon the non-specific teachings of the instant application and the knowledge in the art, the rejection is maintained. Regardless, the specific combination of "soya grits, soya flour and/or a protein extract, e.g. one obtained from soya beans and preferably in flour form, may be used in the preparation of bakery products according to the invention" disclosed by the GB '439 patent.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., utilizing dry mix, kits, various weight ratios or percentages) are not recited in all rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Art Unit: 1761

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 31-52 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,589,584. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the '661 application are drawn to a food ingredient comprising gluten and soy flour, and other additional components.

### ***Priority***

This application is a Continuation-in-Part of serial number 09/293,661. However, the application upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 1-20 of this application. The '661 application fails to provide support for the use of soy grits with gluten as a food ingredient composition. Thus, the instantly-claimed invention is afforded the priority date of the filing date of the instant application, namely December 22, 2000.

Art Unit: 1761

***Conclusion***


Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith Hendricks whose telephone number is (703) 308-2959. The examiner can normally be reached on M-F (8:30am-6pm); First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (703) 308-3959. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9565 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

  
**KEITH HENDRICKS**  
**PRIMARY EXAMINER**